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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NO. 0317MH-23513C

In re Application of:

DANIEL A. HENDERSON

Examiner: BARNIE, R.

Serial No. 09/477,167

Filed: 4 JANUARY 2000

Art Unit: 2743

For: METHOD AND APPARATUS FOR IMPROVED PAGING RECEIVER AND
SYSTEM

RESPONSE

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action mailed 6 July 2000, applicant submits the following remarks. Please charge any necessary fees for prosecution of this Application to Deposit Account No. 50-1060. Any required extension of time is hereby requested. Please charge any necessary fees to Deposit Account No. 50-1060. A Petition for Extension-Two Month and a check in the amount of \$195.00 is enclosed herewith.

CERTIFICATE OF MAILING 37 CFR § 1.8(a)	
I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail service under 37 C.F.R. § 1.8(a) on the date indicated below and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.	
Date of Deposit: <u>6 Dec 2000</u>	By: <u>[Signature]</u>

REMARKS

In response to the Office Action dated 6 July 2000, Applicant has not amended the claims. Claims 1-18 were previously cancelled, Claims 19-39 are currently pending in the application.

As noted in the Preliminary Amendment filed with this continuation, Claims 19-39 were copied from the Jedlicka patent, 5,857,016. The pending claims are identical to the claims issued in the Jedlicka patent.

The present application is a continuation of 08/726,024, filed 4 October 1996. That parent application claimed priority from provisional application Serial No. 60/005,029, filed 6 October 1995. The parent application also claimed priority as a CIP of 08/177,851, filed 5 January 1994. Such priority dates are relevant to the pending rejections of the claims.

The Jedlicka patent has a priority date of 17 September 1996, which is almost one year later than the 6 October 1995 priority date for the present application. In a similar manner, the Karnowski patent has a priority date of 15 February 1996. This is also later than the October 1995 priority date for the present application. Both applications are much later than the January 1994 priority date for the patent application of which the present application is a CIP.

The Provisional Application filed October 6, 1995 includes a complete specification fully supporting Claims 19 through 39 currently pending in the present application. Except for minor corrections, formatting and so forth, the entire text of the Provisional Application filed in October 1995 is included as part of the description for the

current application. For example, the detailed description beginning on Page 2 of the Provisional Application, and ending near the top of Page 33, corresponds to pages 8 through 60 of the present application. This section of the specification describes in detail the technology behind the currently pending claims.

In addition, both the original application, beginning at Page 33, and the claims of the direct parent application to which the present application is a continuation, contain claims directed to the features set forth in the current claims. For example, Claim 7 of the Provisional Application is directed to a paging system which receives an incoming call having Caller I.D., after the call is completed, dials the paging system, transmits the received Caller I.D. information to the paging system, and forwards the caller I.D. information through the paging system to the paging device. Claim 10 of the parent application filed on October 4, 1996 includes this same system.

Thus, support for the present claims is completely contained within the priority document dated October 6, 1995 nearly a year before the filing date of the Jedlicka application. The Jedlicka patent is not available as prior art against the present application, and the rejection based on Jedlicka should be withdrawn. In a similar manner, the rejection over Karnowski Patent 5,907,596 is improper and should be withdrawn. Karnowski has a priority date of February 15, 1996, which comes after the present application's priority date of October 6, 1995. Karnowski is therefore not available as a reference against the present application, and the rejection based on Karnowski should be withdrawn.

The Duncan patent 5,502,761 has a priority date of 24 March 1994. This is later than the January 1994 priority date for the original ancestor application. As described below, all of the teachings of Duncan are contained in the original application filed in January 1994, without needing to include disclosure provided by the provisional application of October 1995. Because of this, for the subject matter shown in Duncan, the present application has a priority date of January 1994, which predates the Duncan patent. Thus, the Duncan reference has been removed as a reference and cannot be applied as prior art against the present application.

The Duncan patent is actually directed to a different invention than is currently claimed in the present application, and was claimed in the Jedlicka patent. Among other things, Duncan teaches a system in which the caller determines whether or not to forward information to the pager. In contrast, the present claims call for the system to dial a paging system "without caller interaction," as provided for in each of the independent claims of the present application. Note that these same features are provided in all of the claims of the Jedlicka. Thus, the rejection of the present claims over Duncan is improper.

Duncan was cited of reference during prosecution of the Jedlicka patent, and appears listed on the front page of Jedlicka. This indicates that the patent office has previously held the claims of the Jedlicka patent to be distinct over the Duncan reference.

In addition, as described above, the priority date of Duncan comes after the priority date of January 1994 for the material included as a continuation-in-part for the present application. The text of the original application filed in January 1994 is included in

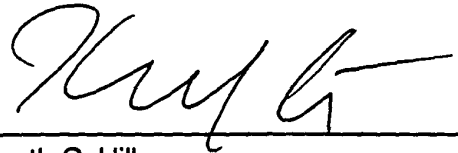
its entirety in the present application at pages 60 through 82. The figure numbers have been changed to take into account the additional figures included in the present application which were derived from the provisional application discussed above.

Figures 13, 14, and 21 of the present application correspond exactly to Figures 3, 4, and 11 of the January 1994 application. These figures, and the accompanying description, provide support for the present claims independent from the provisional application upon which the present application claims priority. Thus, Applicant is entitled to a priority date of January 1994 for these claims, which removes Duncan as a reference against the present application. The rejection of claims based upon Duncan should therefore be withdrawn.

In summary, the provisional application gives a priority date of October 1995 for much of the technical material included in the present application. In particular, the provisional application alone is sufficient to support the currently pending claims, and applicant is entitled to a priority date of October 1995 in support of these claims based upon the provisional. In addition, the precursor application of which the present application is a continuation in part, and having a priority date of January 1994, also supports the present claims without reference to the additional material added by the provisional application. Thus, applicant is entitled to a January 1994 priority date as against the references, and in particular, Duncan. Because applicant's priority dates are earlier than the earliest priority date of the cited applications, the three references cited against the claims are not valid prior art references.

For the reasons described above, none of the three patents cited in the Office Action against the present application are valid as prior art against the present application and claims. Thus, the rejections of the claims under Section 102 are improper, and should be withdrawn. In addition, Applicant has provided a set of claims identical to those issued in the Jedlicka patent, and believes that an interference should be declared with the Jedlicka patent in which Applicant is the senior party.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K. Hill', written over a horizontal line.

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